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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,700	01/17/2002	Shing Young Lee	P67555US0	3601

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EXAMINER

BURGESS, BARBARA N

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/046,700	Applicant(s) LEE, SHING YOUNG	
	Examiner Barbara N. Burgess	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

This Office Action is in response to Amendments filed May 10, 2005. Claims 1-9 are presented for further examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Modeste et al. (hereinafter "Modeste", US Patent Publication 2003/0056012 A1).

As per claim 1, Modeste discloses a remote control method for controlling electrical appliances via home gateway comprising the steps of:

- Preparing a main board provided in an individual house to selectively connect to the INTERNET, wherein the main board remains off-line with respect to the INTERNET when it is not activated (paragraphs [0004, 0034, 0036, 0042]);
- Making a phone call to the main board to initialize the main board (paragraphs [0006, 0037, 0040]);
- Connecting the main board to the INTERNET (paragraphs [0003, 0006, 0034, 0039]);

- Acquiring a pre-registered IP address from a DNS server (paragraphs [0004, 0034, 0049, 0084]); and
- Using a tool accessible to the IP address for communicating with electrical appliances, wherein a data confirmation step is added before the step of the main board connecting to the INTERNET so as to confirm the data input to the main board to initialize the main board (paragraphs [0037, 0051, 0070-0071, 0074]).

As per claim 2, Modeste discloses the remote control method as claimed in claim 1, wherein the main board has a controller with two ports (paragraphs [0036, 0042-0046]).

As per claim 3, Modeste discloses the remote control method as claimed in claim 2, wherein one of the ports is a hub (paragraphs [0036, 0040-0042]).

As per claim 4, Modeste discloses the remote control method as claimed in claim 2, wherein one of the ports is a WAN port (paragraphs [0034]).

As per claim 6, Modeste discloses the remote control method as claimed in claim 1, wherein the main board further has a modem connecting port (paragraphs [0034, 0036, 0038]).

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As per claim 7, Modeste discloses the remote control method as claimed in claim 6, wherein the main board further has a printer connecting port (paragraphs [0034, 0036, 0038]).

As per claim 8, Modeste discloses the remote control method as claimed in claim 1, wherein the tool includes a PC, PDA, GSM mobile phone, WAP mobile phone, GPRS phone or Webpad (paragraphs [0004]).

As per claim 9, Modeste discloses the remote control method as claimed in claim 1, wherein the main board further has a power line modem which engages with household electrical power so that the main board is able to control the various household electrical appliances through an indoor electrical wiring (paragraphs [0034, 0036, 0038]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Modeste et al. (hereinafter "Modeste", US 2003/0056012 A1) in view of Hayes et al. (hereinafter "Hayes", US 6,480,586 B1).

As per claim 5, Modeste discloses the remote control method as claimed in claim 1.

Modeste does not explicitly disclose wherein the main board further has a fax server so as to transmit and receive information. However, in an analogous art, Hayes discloses connecting the appliance server to both the caller ID modem and to data/fax modem (column 11, lines 30-40).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Hayes's fax server in Modeste's method in order to receive data via fax.

Response to Arguments

The Office notes the following arguments:

(a) Modeste provides a gateway to permit Internet connectivity 24 hours a day.

However, the embodiment of the present invention provides a gateway connected with the Internet, and it is initialized only when a phone call is made to activate the gateway, which means the gateway remains off-line with respect to the Internet when it is not been activated.

(b) The gateway will retrieve a pre-registered IP address from a specific DSN.

Therefore, the IP address of the invention is dynamic. In Modeste, each home has its own fixed IP address.

(c) Modeste didn't provide a method or facilities which proceed with an input signal by a telephone call to initialize the main board (gateway) to connect with the Internet, as does the invention.

(d) Hayes is different from the present invention. There is no motivation to combine Modeste and Hayes to achieve the present invention as defined in claim 5.

5. Applicant's arguments filed have been fully considered but they are not persuasive.

In response:

(a), (c) Modeste, indeed, teaches the gateway *permits* Internet connectivity 24 hours a day. However, this does not mean that the gateway is "online" or connected to

the Internet 24 hours a day. According to Modeste, the gateway connects to the Internet when a user establishes connection to the gateway by DSL or Cable Fiber optic. The modem couples the connection to a motherboard. DSL connection includes a phone call to the modem of the gateway (paragraphs [0036, 0038, 0041-0043]). Therefore, the gateway (main board) is connected to Internet only when the user makes a DSL connection. Otherwise, the gateway is considered "offline with respect to the Internet".

(b) Applicant's argument is contradictory to what is claimed. Applicant claims, "acquiring a *pre-registered* IP address from a DNS server", however argues that the IP address is dynamic. If the address is pre-registered, how can it be dynamic? As well, the claim makes no reference to the IP address being dynamic.

According to Modeste, each home is accessed by a specific IP address and each device within the home has its own sub-address (paragraphs [0034, 0040, 0049]). The IP addresses enable the devices to be controlled.

(d) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one would combine Hayes in Modeste in order to receive data via fax.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N. Burgess whose telephone number is (571) 272-3996. The examiner can normally be reached on M-F (8:00am-4:00pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara N Burgess
Examiner
Art Unit 2157

August 4, 2005


ARJO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER